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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,472	01/17/2002	Gabriela Stoianovici	2-1032-184	8708

7590

05/15/2003

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EXAMINER

THEXTON, MATTHEW

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,472

Applicant(s)

STOIANOVICI ET AL.

Examiner

Matthew A. Thexton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: .

**DETAILED ACTION*****Election/Restrictions***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species (or sub-genera) are as follows:

A) for volatile corrosion inhibitor:

- (1) organic non-heterocyclic amines ( aliphatic, aromatic, acyclic, or cyclic amines, such as dicyclohexylamine, cyclohexylamine, diisopropylamine, benzylamine, hexamethylenetetramine) and their organic or inorganic salts (benzoates, carbamates, laureates, caprylates, succinates, nitrites, nitrates, carbonates, phosphates, phosphites);
- (2) heterocyclic compounds (morpholine, imidazole, triazoles);
- (3) alkali or alkaline earth metal salts of nitrous acid;
- (4) alkali or alkaline earth metal salts of benzoic acid;

B) for structuring agent:

- (1) natural waxes (carnauba, bees);
- (2) linear and slightly branched hydrocarbons (mineral waxes (paraffin, microcrystalline, petrolatum, polyethylene), polyolefins);
- (3) oxidized micro-crystalline wax;
- (4) polyglycols (polyethylene glycol);

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(5) saturated or unsaturated mono- or dicarboxylic acids, their esters or salt, or their oxidized derivatives;

(6) phosphoric acid and its alkali, alkaline earth, zinc, or aluminum metal salt;

(7) sulphonic acid and its alkali, alkaline earth, zinc, or aluminum metal salt;

(8) phosphonic acid and its alkali, alkaline earth, zinc, or aluminum metal salt;

(9) alcohol esters of phosphoric acid;

(10) alcohol esters of sulphonic acid (phosphoric ester of C16-18 fatty alcohols);

(11) alcohol esters of phosphonic acid;

(12) cyclic or acyclic compounds of the group consisting of lactones, ketones, aldehydes, and acetals;

(13) cyclic or acyclic amides;

(14) C10 or greater primary or secondary alcohols;

(15) polyalkoxylated C10 or greater primary or secondary alcohols;

C) for polymer: all species can be examined together.

Applicant is required, in reply to this action, to elect a single species for each of A) and B) to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

No claim is limited to a specie of group A or B.

The following claim(s) are generic: All the claims.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

A) the four species (or sub-genera) for volatile corrosion inhibitors are chemically diverse from each other in that they do not share common structure or equivalence in the art.

B) The 15 species (or sub-genera) for structuring agent are chemically diverse from each other in that they do not share common structure or equivalence in the art.

A telephone call was made to Mr. Michael O. Sturm, at 515-288-9589, on 6 May 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Issues Simplifying Prosecution***

It is noted that claim 3 is Multiply Dependent. Accordingly, claims depending therefrom should not be Multiply Dependent. Thus, claims 4-11 should be rewritten to eliminate this fault.

It is noted that claims 3, 4, 5, 6, 8, and 9 employ the phrase "chosen from the group comprising" which is improper Markush language and will be subject to a rejection under 35 USC 112. Proper language is "chosen from the group consisting of." Claim 5, in the third grouping therein, the phrase "compounds of the group comprising" is likewise improper Markush language and should recite "compounds of the group consisting of" rather than "comprising."

Correction of these faults may simplify prosecution.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 703-305-5085. The examiner can normally be reached on Monday-Friday, 8:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Matthew A. Thexton  
Primary Examiner  
Art Unit 1714

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May 14, 2003